The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.
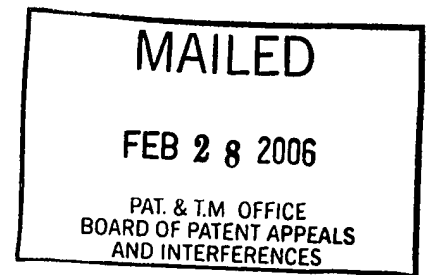
UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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<u>Ex parte</u> DARRELL WAYNE RANDALL, DANIEL RICHARD SCHNEIDEWEND,
MICHAEL JOSEPH MCLANE, MEGAN LOUISE BROWN
and MARK SHERIDAN WESTLAKE

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Appeal No. 2006-0573
Application 09/445,135

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ON BRIEF

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MAILED

FEB 2 8 2006

PAT. & T.M OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before THOMAS, KRASS, and GROSS, <u>Administrative Patent Judges</u>.

THOMAS, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner having twice rejected claims 1 through 13.

Representative claim 1 is reproduced below:

1. An apparatus in which program guide information containing a respective program description for programs is processed to form a program guide, comprising:

control means for displaying concurrently a list of program descriptive fields and an entry for entering a text string;

user control mean for allowing a use to select a program descriptive fields from the list of program descriptive fields and to enter a text string having one or more user-selectable characters in the entry; and

the control means for performing an alphabetical sort of the programs in response to the user selection of the program descriptive field and for locating a first program with the respective program description in the selected program description field in response to the entered text string based on the entered text string.

The following references are relied on by the examiner:

Torres	5,410,692	Apr. 25, 1995
Youman et al. (Youman)	WO 96/17473	June 6, 1996

Claims 1 through 13 stand rejected under 35 U.S.C. § 103. As evidence of obviousness,

the examiner relies upon Youman in view of Torres.

Rather than repeat the positions of the appellants and the examiner, reference is made to

the brief (no reply brief has been filed) for the appellants' positions, and to the last Office Action

issued on November 4, 2004 and the answer for the examiner's positions.

OPINION

We reverse, essentially for two reasons, the rejection of claims 1 through 13 under

35 U.S.C. § 103.

Initially, from our study of the applied prior art and the examiner's positions, first set forth

in the above-noted Office Action, the position taken by the examiner at pages 4 and 5 of this

Office Action based upon a rationale relying upon Youman alone to justify a rejection under

35 U.S.C. § 103 of the claims on appeal is misplaced. Even though we agree with the examiner's

characterization that Youman does not teach displaying concurrently a list of program descriptive

fields and an entry for entering a text string, we do not agree with the examiner's reasoning that it

would have been obvious to do so on the basis of some kind of so-called design choice line of

reasoning to modify Youman without any additional applied prior art. The characterization of the

examiner's rationale as being based upon design choice is highly disfavored. We read the

examiner's reasoning as based essentially upon prohibited hindsight. Thus, we reverse the

rejection of claims 1 through 13 on appeal to the extent that the examiner relies upon Youman

alone.

Secondly, we also reverse the rejection of the claims on appeal even if we assume, for the

sake of argument, that Youman and Torres are properly combinable within 35 U.S.C. § 103. At

the bottom of page 5 of the noted Office Action the examiner asserts that Torres advantageously

displays an entry for entering a text string, a list of descriptive fields and the search results within
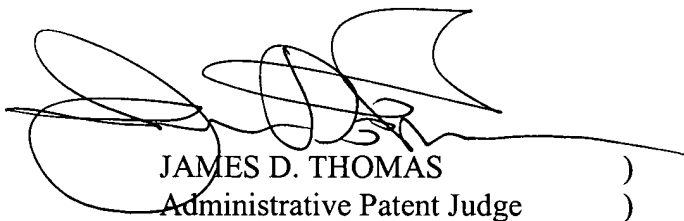
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a single screen as depicted in figure 3. Similar reasoning is expressed by the examiner at the bottom of page 6 of the answer and beginning at the middle of page 7 through the top of page 8 of the answer. What is significant to us in these noted locations of the answer and the earlier Office Action is that the examiner has not specifically identified for our review and study any teaching or showing in Torres of the identified and claimed list of descriptive fields.

Torres shows in figure 2 a conventional search panel with an entered text string 30 in the right portion of this figure. A text value 31 is characterized in this text field 30 in the figure 3 showing. At least with respect to the first iteration or entry of a text string, the search results box is shown at the bottom left of this figure. In a corresponding manner, according to the teachings relied upon by the examiner in Torres, figure 4 in turn shows a modified or new search text string 37 in the text string box 30 and the old and new results are shown in the search result box at the lower left of this figure. It is thus readily apparent to us and to the readers of Torres that the claimed text string and the ability to enter this information is taught, as one of the claimed features, as urged by the examiner as well as the additional feature of the search results within a single screen being shown after the database is searched.

On the other hand, the examiner has not specifically identified for our review any corresponding teaching of descriptive fields as required by the claims on appeal from any of the figures and text teachings in Torres. Correspondingly, we are unable to find any from our own study of this reference. To the extent that the examiner inherently relies upon the database box in figures 2 through 5 as indicating various data files 1 through n as the claimed list of program descriptive fields, this view is incorrect. From our understanding of the manner in which this reference operates, the entire database of files 1 through n is searched in accordance with the text string entered into the search criteria box as well as the new text string entered in the search criteria box among figures 3 and 4. Thus, there is no ability to select, as required by independent claims 1, 6 and 12 on appeal, any particular file from those listed as files 1 through n from which in turn a text string is entered as search criteria.

Thus, if we were to agree with the examiner's basic position that it would have been

obvious for the artisan to have combined Youman and Torres within 35 U.S.C. § 103, it does not

appear to us that the requirements of independent claims 1, 6 and 12 would have been met. As a

result of these findings, we must necessarily reverse the rejection of claims 1 through 13 on appeal

since we do not sustain the rejection of independent claims 1, 6 and 12. Therefore, the decision of

the examiner is reversed.

<div align="center">REVERSED</div>

JAMES D. THOMAS)
Administrative Patent Judge)
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) BOARD OF PATENT
ERROL A. KRASS) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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ANITA PELLMAN GROSS)
Administrative Patent Judge)

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Application 09/445,135

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